

REMARKS

Favorable reconsideration and allowance of the application are respectfully requested in view of the following remarks. Claims 1-10 and 21-31 were pending prior to this Office Action. Claims 32 and 33 are added through this Reply. Therefore, claims 1-10 and 21-33 are pending. Claims 1 and 21 are independent.

ALLOWABLE SUBJECT MATTER

Applicants appreciate that the Examiner considers claims 2, 5, 8, and 10 to define allowable subject matter. *See Office Action, items 6 and 7.* Applicants note that claims 6 and 9 are not explicitly rejected in the Office Action. In the previous Office Action dated December 29, 2004, the Examiner indicates that claims 6 and 9 define allowable subject matter. Therefore, Applicants will consider that the status of claims 6 and 9 have not changed, i.e., the Examiner still considers these claims to define allowable subject matter.

PROVISIONAL DOUBLE PATENTING

Claims 1, 4, and 21 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1, 4, and 7 of a co-pending application 10/413,584 (U.S. Publication No. 2003/0224256). *See Office Action, items 1-2.* Applicants respectfully disagree.

The Examiner alleges that claim 1 of the present application claims a common subject matter as claim 1 of the co-pending application. In claim 1 of the present application, it is recited in part "starting illumination of a laser beam from a laser oscillator onto a light-photosensitive heat-developing photosensitive material." In contrast, claim 1 of the co-pending application merely states "supplying a photosensitive material comprising a base layer having formed on a surface thereof an emulsion layer; and a radiating a laser beam onto the emulsion layer." As recited, claim 1 of the present application specifically recites a source of the laser beam, i.e., the laser oscillator, while claim 1 of the co-pending application provides no such recitation. For at least this reason, claim 1 of the present application and claim 1 of the co-pending application do not claim common subject matter.

Claim 4 of the present application depends from claim 1. However, claim 7 in the co-pending application is an independent claim. Claim 7 of the co-pending application recites "supplying a photosensitive material comprising a support having formed on at least one side thereof an emulsion layer." *Emphasis added.* However, neither claim 1 or claim 4 of the present application claims such an element. Clearly, claim 4 of the present application and claim 7 of the co-pending application do not claim a common subject matter.

Finally, regarding claim 21, the Examiner combines claims 4 and 7 of the co-pending application and alleges that claim 21 claims a common subject matter with the combination of claims 4 and 7 of the co-pending application. However, as noted above, claim 4 of the co-pending application depends from claim 1, not claim 7. Clearly, the Examiner's allegation cannot stand.

For at least the above stated reasons, Applicants respectfully request that the provisional double patenting rejection of claims 1, 4, and 21 of the present application based on claims of the co-pending application be withdrawn.

§ 103 REJECTION – KENJIRO, NAKAMURA

Claims 1, 3-4, 7, 21-23, and 27-28 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kenjiro (JP 59-19253)¹ in view of Nakamura et al. (U.S. Patent No. 5,940,115). Applicants respectfully traverse.

Claim 1 recites, in part "starting illumination of a laser beam from a laser oscillator onto a light-photosensitive heat-developing photosensitive material." *Emphasis added* In the Office Action, the Examiner admits that Kenjiro is silent regarding the nature of the laser beam. However, the Examiner alleges

¹ In the Office Action, the Examiner states that JP 59-19253 is Nakane et al. Our review of the Abstract indicates that the inventor is Watanabe Kenjiro.

that Nakamura teaches the laser oscillator as claimed. Contrary to the Examiner's allegation, Nakamura cannot be so relied upon.

Nakamura merely discloses that a plurality of laser beam generating tubes 20a - 20g are used as laser beam sources. Nakamura is completely silent regarding the particularities of the laser beam tubes themselves. In the responses to the arguments section of the Office Action, the Examiner alleges that the laser beam generating tubes as disclosed in Nakamura is equivalent to the laser oscillator as claimed. The Examiner points to page 8, lines 1-6 of the present application as evidence that laser generating tubes of Nakamura is equivalent to the laser oscillators as claimed. The recited portion of the specification merely indicate that the laser oscillator may come in the form of a tube. However, it is an unreasonable leap to allege that the laser beam generating tube, without more, is the same as the laser oscillator as claimed.

Further, Nakamura and Kenjiro cannot be properly combined. Nakamura clearly discloses that through the use of the laser tubes 20a - 20g on the photosensitive material, heat is applied to the surface of the emulsion layer 61 and a sublimation occurs on the emulsion layer 61. *See Nakamura, column 9, lines 9 - 17.* In other words, Nakamura discloses that the surface of the emulsion layer 61 is deformed. This is in clear contrast to the feature "forming a cavity at an interior of the surface layer by energy of the laser beam." Thus, when taken as a whole, even if Kenjiro is assumed to teach or

suggest the feature of forming a cavity at an interior of the surface layer, Nakamura clearly teaches away.

For at least the above stated reasons, independent claim 1 is distinguishable over the combination of Kenjiro and Nakamura. Claims 3-4, 7, and 22-23 depend from independent claim 1 directly or indirectly. Therefore, for at least the reasons stated above with respect to independent claim 1, these dependent claims are also distinguishable over the combination of Kenjiro and Nakamura.

The dependent claims are also distinguishable on their own merit. For example, claim 22 recites, in part, "deflecting the laser beam onto the light-photosensitive heat-developing photosensitive material." In the Office Action, the Examiner alleges Nakamura teaches using a polygon mirror as a beam deflector for directing a scanned laser beam onto the photosensitive material. *See Figure 5 of Nakamura.*

Contrary to the Examiner's allegation, Nakamura actually teaches against using the polygon mirror. Nakamura clearly indicates that the use of the mirror causes a dot of the laser beam to be extended in a form of an oval in the main scanning direction as shown in Figures 6(a), 6(b) and 6(c). Nakamura states "as a result, since the density value of black on the line component in the main scanning direction becomes darker than that of the line component in the sub-scanning direction ... density irregularities takes place on the marked

character." *See Nakamura, column 2, lines 7-12.* Because the use of the mirror causes irregularities, Nakamura overcomes this problem by not using the polygon mirrors at all. Thus, contrary to the Examiner's allegation, Nakamura does not teach using a polygon mirror as a beam deflector.

Independent claim 21 recites, in part, "starting illumination of a laser beam from a laser oscillator." It has been amply demonstrated above that neither Kenjiro nor Nakamura may be relied upon to teach or suggest at least this feature.

Independent claim 21 also recites, in part, "forming a cavity at an interior of the surface layer." It has been amply demonstrated above that Kenjiro and Nakamura may not be properly combined to teach or suggest this feature. Therefore, independent claim 21 is distinguishable over the combination of Kenjiro and Nakamura.

Claims 27-28 depend from independent claim 21. Therefore, claims 27 and 28 are also distinguishable over the combination of Kenjiro and Nakamura.

Further, claim 27 recites in part, "deflecting a laser beam onto the light-photosensitive heat-developing photosensitive material." As demonstrated above, claim 27 is also distinguishable on its own merit.

Applicants respectfully request that the rejection of claims 1, 3-4, 7, 21-23, and 27-28 based on Kenjiro and Nakamura be withdrawn.

§ 103 REJECTION – KENJIRO, NAKAMURA, SMART

Claims 24-26 and 29-31 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kenjiro in view of Nakamura and in further view of Smart (U.S. Patent No. 6,339,604). Applicants respectfully traverse. Applicants note that claims 24-26 and 29-31 depend from independent claims 1, or 21 directly or indirectly. As demonstrated above, claims 1 and 21 are distinguishable over the combination of Kenjiro and Nakamura. Smart has not been, and indeed cannot be, relied upon to correct for at least the above noted deficiencies of Kenjiro and Nakamura. Therefore, independent claims 1 and 21 are distinguishable over the combination of Kenjiro, Nakamura, and Smart.

At least due to the dependency thereon, claims 24-26 and 29-31 are also distinguishable over the combination of Kenjiro, Nakamura, and Smart. Applicants respectfully request that the rejection of claims 24-26 and 29-31 based on Kenjiro, Nakamura and Smart be withdrawn.

NEW CLAIMS

Claims 32 and 33 are added through this Reply. These claims depend from independent claims 1 and 21, respectively. Therefore, for at least the reasons stated above with respect to the independent claims, the new claims 32 and 33 are also distinguishable over all cited references of record, individually, or in any combination.

Applicants respectfully request that the new claims be allowed.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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